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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92046037
Party	Defendant NOVATECH SA
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Submission	Opposition/Response to Motion
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Attachments	1811-71 Response to 56(f) Motion.pdf ( 17 pages )(443366 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 3,093,389  
Registered on: May 16, 2006

BRYAN CORPORATION,	§	
	§	
Petitioner,	§	
	§	
v.	§	Cancellation No. 92046037
	§	
NOVATECH SA,	§	
	§	
Registrant.	§	

**REGISTRANT'S RESPONSE TO PETITIONER'S RULE 56(f) MOTION**

NOVATECH SA ("Registrant"), has moved under Rule 2.127 of the Trademark Rules of Practice and Federal Rule of Civil Procedure 56 for summary judgment and dismissal of BRYAN CORPORATION's, ("Petitioner") Petition to Cancel Registrant's trademark registration No. 3,093,389 for the mark STERITALC. Petitioner now responds to Registrant's Rule 56(f) Motion filed on December 21, 2007.

**DISCUSSION**

1.       The Board issued an Order on Petitioner's Motion to Compel on September 28, 2007 requesting that Registrant answer the fifth interrogatory in Petitioner's Second Set of Interrogatories. *See* [September 28, 2007 Order]. Registrant complied with the Board's Order on November 5, 2007 when it served its Supplemental Answers to Petitioner's Second Set of Interrogatories to Petitioner. *See* [Ex. 1, Supp. Ans. to 2nd Set of ROGS].

2.       Petitioner filed a Motion to Compel on November 30, 2007 on the faulty premise that no supplemental response to an interrogatory was ever made by Registrant. Petitioner has now conceded in its Rule 56(f) Motion that it has received Registrant's supplemental answers to

interrogatories. Petitioner's Motion to Compel is now moot and the Reply in Support of Its Motion to Compel Discovery Responses, served concurrently with its Rule 56(f) Motion, should be stricken from the record. Petitioner's reply brief does not support the Motion to Compel, but instead improperly changes the argument of the original motion to a discussion of the adequacy of the interrogatory response. *See* TBMP §502.02(b). Since a surreply by Registrant is not permitted, the Board should not consider Petitioner's improper reply. *See id.* (explaining that it is in the discretion of the Board whether it will consider a reply brief in support of a motion).

3. Registrant is now in receipt of Petitioner's Rule 56(f) Motion claiming Registrant's answer to the fifth interrogatory in Petitioner's Second Set of Interrogatories is inadequate in a way that will prevent Petitioner from adequately respond to Registrant's Motion for Summary Judgment filed on November 28, 2007. Registrant submits that the primary contention of its Motion for Summary Judgment is the issue of standing. Petitioner has based its standing on its alleged interest in a generic mark. If Petitioner is found to lack standing, the Board will not be required to make a decision on the issues of likelihood of confusion or fraud.

4. Petitioner seeks to hold up the Board's decision on standing by insisting that Registrant has not "meaningfully responded" to an interrogatory it claims is necessary to "fully develop the factual record" of Petitioner's fraud claim. Registrant argues that not only is a 2nd supplemental response unnecessary for Petitioner to respond to Registrant's Summary Judgment motion, but that Registrant's supplemental interrogatory answer is indeed a sufficient response. *See* FRCP 56(f); *see* [Ex. 1, Supp. Ans. to 2nd Set of ROGS, No. 5].

5. In resolving this dispute the Board should first look at the question served by Petitioner. *See* [Ex. 1, Supp. Ans. to 2nd Set of ROGS, No. 5]. Petitioner put forth the following

interrogatory: “State whether your belief that you are “entitled to use” the STERITALC mark in commerce, as set forth in the Declaration you signed in connection with your application Serial No. 79/008,374, means that on the date of the Declaration you believed you have the right to sell a drug that bears the name STERITALC in U.S. commerce.” *Id.* In the interrogatory, Petitioner has taken the term “entitled to use,” a term of art in trademark law, and proceeds to supply an erroneous legal definition to that term of art. *See id.*

6. Petitioner is apparently using this Rule 56(f) to seek a yes or no answer to its interrogatory that includes a misstatement of law. However, it is clear that a simple “yes” answer may give Petitioner the mistaken assumption that we agree with the misstatement of law. A simple “no” answer may give Petitioner the mistaken assumption that Registrant did not believe he was “entitled to use” the STERITALC mark in commerce on the date the Declaration was signed for the application. Registrant has instead decided to properly answer Petitioner’s interrogatory by stating that Registrant believed that he was “entitled to use” the STERITALC mark in commerce and that his belief “meant” exactly what was written in the declaration, not the misstatement of law found in the interrogatory. *See* [Ex. 1, Supp. Ans. to 2nd Set of ROGS, No. 5].

7. Registrant’s supplemental answer to Petitioner’s interrogatory makes it clear what Registrant’s state of mind was when filing its declaration. It is obvious in the answer that Registrant believed he was “entitled to use” the STERITALC mark. Under Rule 56(f), a party claiming that it needs discovery must submit an affidavit that sets forth reasons why the party cannot present facts essential to justify its opposition to the motion for summary judgment. *See* FRCP 56(f). The Declaration of Daniel G. Jarcho claims a single interrogatory precludes Petitioner from answering the Motion for Summary Judgment, and then makes the conclusory statement that the Petitioner

“cannot respond to [Registrant’s] claim” without the requested information. *See* [Declaration of Daniel G. Jarcho, ¶13]. No reasons are set forth in the declaration on why a response cannot be made through other means. More is required than vague assertions regarding the nature of facts that may be uncovered. *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 1390 (Fed. Cir. 1989). The request for discovery must “be adequately supported by a showing of need.” *Id.*

8. The Board should not allow Petitioner to rely on Rule 56(f) to delay this proceeding any further. The motion has simply been used as a means to delay a final decision on the merits of Registrant’s Motion for Summary Judgment for lack of standing. Registrant has properly responded and answered three sets of discovery in this proceeding and is now incurring unnecessary expenses in defending Petitioner’s motion to compel and Petitioner’s Rule56(f) motion. Furthermore, the Board’s time and resources are being wasted with these unnecessary motions.

### **CONCLUSION**

Based on the foregoing, Registrant respectfully requests that the board deny both Petitioner’s Motion to Compel Discovery and Rule 56(f) Motion. Registrant further requests that the Board grant Registrant’s Motion for Summary Judgment Dismissing This Cancellation Proceeding for lack of standing in due course.

Respectfully submitted,

January 7, 2008  
Date

/1811-71/  
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L. Jeremy Craft

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ATTORNEYS FOR REGISTRANT  
NOVATECH SA

**CERTIFICATE OF SERVICE**

This is to certify that on this 7th day of January 2008, a true and correct copy of the foregoing document is being sent by regular mail to the following attorney of record for the Petitioner:

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Andrew J. Park  
McKenna Long & Aldridge LLP  
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Washington, D.C. 20006  
(202) 496-7500  
(202) 496-7756 fax

ATTORNEYS FOR PETITIONER  
BRYAN CORPORATION

/1811-71/  
John S. Egbert

# EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 3,093,389  
Registered on: May 16, 2006

BRYAN CORPORATION,

Petitioner,

v.

NOVATECH SA,

Registrant.

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Cancellation No. 92046037

**REGISTRANT'S SUPPLEMENTAL ANSWERS TO PETITIONER'S SECOND SET OF  
INTERROGATORIES**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure, NOVATECH SA ("Registrant"), by its attorneys, hereby submits the following objections and supplemental answers to BRYAN CORPORATION'S ("Petitioner") Second Set of Interrogatories as follows:

**GENERAL OBJECTIONS**

1. Registrant objects to Petitioner's Interrogatories to the extent they seek information subject to the attorney/client privilege, or within the attorney's work product immunity, or other grounds of immunity from discovery.
2. Registrant objects to Petitioner's Interrogatories to the extent they seek information that is unreasonably cumulative, duplicative, or obtainable from some other source that is more convenient, less burdensome, or less expensive.
3. Registrant objects to Petitioner's Interrogatories to the extent that the burden or expense of the Interrogatory outweighs its likely probative value.



4. Registrant's responses are based upon information and writings presently available to and located by Registrant and its attorneys. Registrant has not completed its investigation of the facts relating to this Cancellation, its discovery in this action, nor its preparation for trial. All the information supplied is based only on such information and documents which are presently and specifically known to Registrant. Therefore, Registrant's written responses are without prejudice to its rights to supplement or amend its written responses and to present evidence discovered hereafter at any hearing or trial.

5. Registrant objects to Petitioner's Interrogatories instructions and definitions to the extent they seek to impose burdens contrary to or in addition to those provided in the Federal Rules of Civil Procedure or the Trademark Rules of Practice. Accordingly, Registrant will produce documents identified in its responses in accordance with the applicable rules.

#### **INTERROGATORIES**

1. State whether you have ever, at any time in the past or present, sold a drug in the United States that bears the name STERITALC.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory cannot be expected to yield information relevant to the allegations of the complaint, to the proposed relief, or to the defenses of Petitioner. Without waving these objections or any others, Registrant responds that Registrant sold aerosol STERITALC in the United States under Investigational New Drug Application (IND) procedure in 1996.

2. If you have ever sold, at any time in the past or present, a drug bearing the name STERITALC in the United States, identify the drug, state whether the drug was approved by the

Food and Drug Administration (FDA), state the period of the sales, the dollar amount of the sales, the number of units of drugs sold, and identify the purchasers.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory cannot be expected to yield information relevant to the allegations of the complaint, to the proposed relief, or to the defenses of Petitioner. Registrant objects to this interrogatory on the grounds that it seeks information that is beyond proper scope of discovery of this Cancellation proceeding. Without waving these objections or any others, Registrant responds that Registrant sold aerosol STERITALC in the United States under an Investigational New Drug Application (IND) procedure in 1996. Registrant used the IND procedure to sell STERITALC brand aerosol sterile talc powder with permission from the FDA Division of Oncology. The FDA allowed registrant to send hospitals two canisters of STERITALC brand aerosol sterile talc powder per patient if a physician faxed a request to the FDA. The FDA would then assign an IND number to each request. Registrant's central file number for its facilities was number 9613846. The FDA labeler code number for Registrant was No. 62327. The FDA assigned LI 0060295 as the Drug Product Listing number for STERITALC on Registrant's form FDA 2657.

3. State whether you believe it is lawful to sell the STERITALC drug in the U.S. without FDA approval.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory calls for a legal conclusion. The interrogatory calls for information that is protected by the Attorney/Client privilege. The interrogatory cannot be expected to yield information relevant to the allegations of the complaint, to the proposed relief, or to the defenses of Petitioner.

4. State whether the drug label you submitted as evidence of the use of the STERITALC mark in connection with application Serial No. 75/076,198 is a sample of a label that was affixed to drugs sold in U.S. commerce.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory cannot be expected to yield information relevant to the allegations of the complaint, to the proposed relief, or to the defenses of Petitioner.

5. State whether your belief that you are "entitled to use" the STERITALC mark in commerce, as set forth in the Declaration you signed in connection with your application Serial No. 79/008,374, means that on the date of the Declaration you believed you have the right to sell a drug that bears the name STERITALC in U.S. commerce.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory calls for information that is protected by the Attorney/Client privilege. Without waving these objections or any others, the STERITALC mark was filed under 66(a) as an intent to use application and was based on an international registration. Registrant signed a Declaration in connection with application Serial No. 79/008,374. The Declaration meant that Registrant "believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive." Registrant relies solely on the statement as it is written in the Declaration contained within the application.

6. State whether your belief that you are "entitled to use" the STERITALC mark in commerce, as set forth in the Declaration you signed in connection with your application Serial No. 79/008,374, incorporates by this reference the general objections set forth above. In addition, the interrogatory calls for a legal conclusion. The interrogatory calls for information that is protected by the Attorney/Client privilege. The STERITALC mark was filed under 66(a) as an intent to use application and was based on an international registration.

7. Identify and describe the facts and documents upon which you will rely to support your response to Interrogatory Nos. 6 and 7.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory calls for a legal conclusion. The STERITALC mark was filed under 66(a) as an intent to use application and was based on International Registration No. 0667961.

8. State whether it is your contention that the STERITALC mark can be used in U.S. commerce under the Lanham Act without FDA approval of the STERITALC drug.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory calls for a legal conclusion. The interrogatory cannot be expected to yield information relevant to the allegations of the complaint, to the proposed relief, or to the defenses of Petitioner. The interrogatory calls for information that is protected by the Attorney/Client privilege. Without waving these objections or any others, Registrant responds the STERITALC mark was filed under 66(a) as an intent to use application and was based on an international registration. Registrant

plans to obtain approval of the STERITALC drug by the FDA before using the STERITALC mark in U.S. commerce.

9. If it is your contention that the STERITALC mark can be used in U.S. commerce under the Lanham Act without FDA approval of the STERITALC drug, state how the STERITALC mark can be used in U.S. commerce.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory calls for a legal conclusion. The interrogatory cannot be expected to yield information relevant to the allegations of the complaint, to the proposed relief, or to the defenses of Petitioner. The interrogatory calls for information that is protected by the Attorney/Client privilege. Without waving these objections or any others, Registrant responds the STERITALC mark was filed under 66(a) as an intent to use application and was based on an international registration. Registrant plans to obtain approval of the STERITALC drug by the FDA before using the STERITALC mark in U.S. commerce.

10. State whether you made any inquiry at any time prior to the filing of your application Serial No. 79/008,374 to determine whether there may be any obstacles to the FDA approval of the STERITALC drug.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory calls for a legal conclusion. The interrogatory calls for information that is protected by the Attorney/Client privilege. The interrogatory cannot be expected to yield information relevant to the allegations of the complaint, to the proposed relief, or to the defenses of Petitioner. Registrant objects to this interrogatory on the grounds that it seeks information that is beyond proper scope of discovery. Without waving these objections or any others, Registrant

responds the STERITALC mark was filed under 66(a) as an intent to use application and was based on an international registration. Registrant plans to obtain approval of the STERITALC drug by the FDA before using the STERITALC mark in U.S. commerce and expects to obtain such approval without any problems.

11. State whether you currently have a pending FDA application for the STERITALC drug.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory calls for information that is protected by the Attorney/Client privilege. The interrogatory cannot be expected to yield information relevant to the allegations of the complaint, to the proposed relief, or to the defenses of Petitioner. Registrant objects to this interrogatory on the grounds that it seeks information that is beyond proper scope of discovery. Without waving these objections or any others, Registrant responds that there is not a pending FDA application for the STERITALC drug as of the date of this Answer to Interrogatories.

12. State whether you were aware, on the date you signed the Declaration in connection with your application Serial No. 79/008,374 that Bryan Corporation had an approved NDA for STERILE TALC POWDER.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory calls for a legal conclusion. The interrogatory cannot be expected to yield information relevant to the allegations of the complaint, to the proposed relief, or to the defenses of Petitioner. Registrant objects to this interrogatory on the grounds that it seeks information that is beyond proper scope of discovery. Without waving these objections or any others, Registrant responds that it did not learn of an approved NDA for Petitioner's sterile talc powder in a vial until after its December 28, 2004 filing date for STERITALC in International Class 005.

13. State whether you conducted an availability search to determine if any third parties have registered and/or are using a mark in the U.S. that is the same or similar to the STERITALC mark prior to the filing date of your application Serial No. 79/008,374.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory calls for a legal conclusion. The interrogatory calls for information that is protected by the Attorney/Client privilege.

14. Identify and describe any and all correspondence between the FDA and you in connection with your April 17, 1997 FDA application and in connection with any other FDA applications for the STERITALC drug.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory calls for a legal conclusion. The interrogatory calls for information that is protected by the Attorney/Client privilege. The interrogatory cannot be expected to yield information relevant to the allegations of the complaint, to the proposed relief, or to the defenses of Petitioner. Registrant objects to this interrogatory on the grounds that it seeks information that is beyond proper scope of discovery. Without waving these objections or any others, please refer to Registrant's Responses to Petitioner's Second Set of Requests for Production.

15. Identify and describe the facts and documents upon which you will rely to support each of your three (3) affirmative defenses to the Petition to Cancel as stated in your Answer.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory calls for a legal conclusion. The interrogatory calls for information that is protected by the Attorney/Client privilege. Also, The interrogatory is an improper attempt to

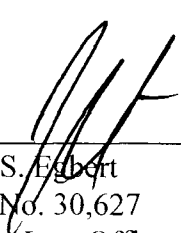
require Registrant to list all factual assertions or contentions in this case, marshal all of its available proof, or marshal all proof Registrant intends to offer.

16. Identify and describe the facts and documents upon which you will rely to support your denial of the allegations in Paragraph 12 of the Petition to Cancel.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory calls for a legal conclusion. The interrogatory calls for information that is protected by the Attorney/Client privilege. Also, The interrogatory is an improper attempt to require Registrant to list all factual assertions or contentions in this case, marshal all of its available proof, or marshal all proof Registrant intends to offer.

Respectfully submitted,

November 5, 2007  
Date



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ATTORNEY FOR REGISTRANT  
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## CERTIFICATE OF SERVICE

record for Petitioner at the following address:

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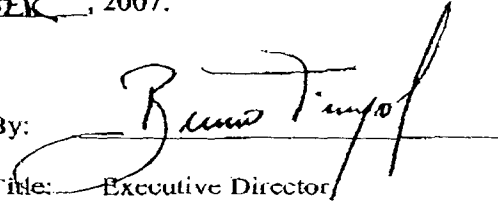
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### VERIFICATION

I, Bruno Ferreyrol, officer for Registrant Novatech SA, hereby declare that I have read the foregoing Registrant's Supplemental Response to Petitioner's Second Set of Interrogatories (Nos. 1 to 16), and know the contents thereof; that said responses were prepared with the assistance and advice of counsel, upon which I have relied; that the responses set forth herein, subject to inadvertent or undiscovered errors, are based on and therefore necessarily limited by the records and information still in existence, presently recollected, and thus far discovered in the course of the preparation of the responses; that consequently, Registrant reserves the right to make any changes in its responses if it appears at any time that omissions or errors have been made therein or that more accurate information is available; and that based upon the foregoing, the undersigned declares that to the best of his knowledge, information and belief, the foregoing answers are true and correct.

DATED this 31<sup>st</sup> day of OCTOBER, 2007.

By:

Title:  Executive Director

Name: Ferreyrol, Bruno

Address: Novatech S.A.

1058 Voie Antiope - Zi Athélia 3

F - 13705 LA CIOTAT CEDEX

Our File: 1811-71